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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,278	05/18/1999	DAVID M. GOLDBERG	018733/916	3688
26633	7590	11/01/2007		
HELLER EHRMAN LLP 1717 RHODE ISLAND AVE, NW WASHINGTON, DC 20036-3001			EXAMINER RIMELL, SAMUEL G	
			ART UNIT 2164	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/313,278

**Applicant(s)**

GOLDENBERG, DAVID M.

**Examiner**

Sam Rimell

**Art Unit**

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



**SAM RIMELL**  
PRIMARY EXAMINER

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

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Preliminary Notes:

(1) Prosecution is hereby re-opened pursuant to 37 CFR 1.198 and MPEP 1214.07.

(2) Prosecution is hereby re-opened after consideration of the decision of the Board of Appeals, dated June 27, 2007, in the section entitled "Other Issue", where a new grounds of rejection was proposed in the decision. The present office action incorporates the proposed new grounds of rejection.

(3) Interviews will be granted in response to this office action, as stated in the miscellaneous communication of July 13, 2007.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (U.S. Patent 6,039,688) in view of Nicol et al. (U.S. Patent 5,287,448).

Claim 39: FIG. 1 illustrates a patient and a physician connected to a system interface (18). Any communication made by the physician or patient to the system interface is considered an inquiry from a user. The physician and patient can access different services, with each service being considered a "level of service".

(I) First level of service: Col. 14, lines 38-52 of Douglas et al. describe a first level of service. Col 14, line 40 describe a user generating information about the rewards points system and their own reward points, which occurs by clicking the icon (92) in Fig. 9. The searching of the database in this case is the searching of the record in the computer system containing user's

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number of accumulated points and identifying the accumulated points, as well as details of the rewards system. The results of the search are delivered to the user by allowing the user to view the information (col. 14, line 40).

Douglas differs in that it does not determine a level of user sophistication, or tailor the resulting information based on that sophistication. However, col. 8, lines 35-46 of Nicol et al. describe a help menu feature added to a user interface, in which a user enters their relative level of sophistication, such as “novice”, “moderate”, or “experienced”. The search results then presented to user in response to an information request is then specifically tailored to the input sophistication. A more experienced user will receive less information and a less experienced user will receive more information.

Accordingly, it would have been obvious to one of ordinary skill in the art to modify Douglas et al. to incorporate a help menu at any one or all of its user interfaces for input of user sophistication so as to tailor the specific output results to the user’s level of sophistication. This provides the advantage of outputting appropriate messages to aid the user (col. 2, lines 46-47 of Nicol et al).

*(All remaining quotations herein are from Douglas et al.)*

Claim 40: (II) Second level of service: Col. 16, lines 21-55 describe a second level of service, in which searches are made on the database (computer system) in order to locate “more information”, such as a list of articles and internet sites. (III) Third level of service: FIG. 48 illustrates a third level of service in which a user (Fred) is provided with a list of healthcare professionals (Susan). The user (Fred) is referred to the health professional (Susan) via the on-line conferencing arrangement of FIG. 48. (IV) Fourth level of service: Col. 17, lines 51-60

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outline a fourth level of service is which the physiological condition (vital signs, blood pressure, weight) are monitored. Col. 6, lines 7-13 outline the administration of treatment by ordering that the patient take certain medications or participate in support groups.

Claims 41-43: The method steps defined by Douglas et al. meet each of parts (A), (B) and (C) defined in claim 40.

Claim 44: The levels of service may be accessed in any order. For example, the user can perform a search of articles and Internet sites (Second Level) before having an on-line meeting with health professional (Third Level of Service). After a given period of time, the user can take recommended medications or participate in support groups (Fourth Level of Service), such as the next day after meeting with the health professional.

Claims 45-47: The method steps defined by Douglas et al. meet each of parts (B) and (C) as defined in claim 40.

Claim 48: FIG. 57 of Douglas et al. illustrates a utilization review system. The user preference is the norm established for the percentage of patients which are desired to be using the system (The listed norm is 17.3%). The weighing function is the measurement of each physician's percentage of patients who participate in the program. The physicians are thus ranked by the percentage of the patients under their supervision who participate in the program. The selection of the user is the designation of which physicians are on the list shown in FIG. 57.

Claim 49: The method of Douglas et al. includes step (C) from claim 40.

Claim 50: As described at col. 6, line 7-13, the user can be instructed via the system to take a medication. These are the telemedicine signals sent to the patient. The implanted device is thus whatever drug the user is asked to take and which releases chemicals into the body.

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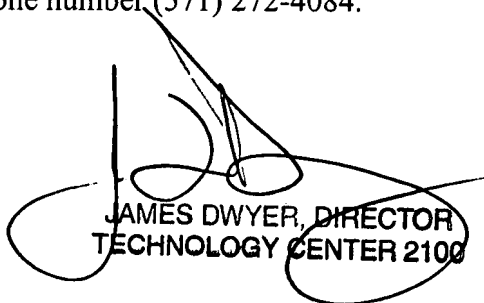
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. in view of Official Notice.

Claim 51: Within the system of Douglas et al., the user can be asked remotely to take medication, but is not asked to undergo surgery. However, Examiner takes Official Notice that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician - patient interaction. It would therefore have been obvious to one of ordinary skill in the art to modify Douglas et al. to include a recommendation to the remote patient that the patient undergo surgery so as to improve the patient's health and prevent or eliminate disease as is well known in the art.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



JAMES DWYER, DIRECTOR  
TECHNOLOGY CENTER 2100



Sam Rimell  
Primary Examiner  
Art Unit 2164